



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,287	11/17/2003	Brent T. Hailpern	YOR920030524US1	4437
7590 02/11/2008 Moser, Patterson & Sheridan Suite 100 595 Shrewsbury Avenue Shrewsbury, NJ 07702				
EXAMINER AUGUSTIN, EVENS J				
ART UNIT 3621		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/715,287

Applicant(s)

HAILPERN ET AL.

Examiner

EVENS J. AUGUSTIN

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Acknowledgements*

1. This is in response to an amendment filed on 11/13/2007. Claims 1 and 16 have been cancelled. Claims 1-26 are pending and have been examined.

### *Response to Arguments*

2. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on 11/13/2006, but has not found those arguments to be persuasive.

**Argument 1:** Prior Art does not teach the aspects of a software application in a hardware device where the hardware is configured to sit between a software manufacturer and end user computer

- A. **Response 1:** The USPTO contends that the language of “where the hardware is configured to sit between a software manufacturer and end user computer” is not claimed by applicant. With regard to the claimed language of “distributing said hardware device for connection to an end user device” in claim 1, the PTO contends that the aspect of “...for connection to an end user device” is considered intended use language. Limitations that recite the purpose of a process or the intended use of a structure are generally not given any patentable weight. Patentable weight is therefore given to the actual process steps or structural limitations. Nevertheless, the prior teaches a software-implemented agent 202 executes on the computing devices within the appliance (col. 6, ll. 56-58). The appliance in question provide application services to users. Network appliances 117 include, for example, computers, printers,

file servers, mass storage and the like (C6, L4-6). According to Microsoft Press Computer dictionary, a server is defined as "n. 1. On a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers and disk drives, and **provides resources to computers functioning as workstations on the network**. 2. On the Internet or other network, a computer or program that **responds to commands from a client**. For example, a file server may contain an archive of data or program files; when a client submits a request for a file, the server transfers a copy of the file to the client". Therefore, the appliance in question is device can be a computer functioning in between a client and another computer.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-15 and 24-26 are rejected under 35 U.S.C. 102(c) as being anticipated by Kouznetsov et al. (U.S. 6931546).
3. As per claims 1-15 and 24-26, Kouznetsov et al. discloses an invention that ("relates, in general, to application software, and, more particularly, to software, systems and methods for providing application services with controlled access into privileged processes. The invention comprises of the following:
  - A. ("**providing a software application on a hardware device by a manufacturer of said software application, wherein said software application is executable on said hardware device**")—A software-implemented agent 202 executes on the computing devices within the appliance (col. 6, ll. 56-58)—
  - B. ("**distributing said hardware device for connection to an end user computer**")—System and method for deployment of applications services via dynamic distribution of software (col. 9, ll. 1-2) - invention takes place in distribute computing environment (col. 5, ll. 16-17) -- The appliance in question provide application services to users. Network appliances 117 include, for example, computers, printers, file servers, mass storage and the like (C6, L4-6). According to Microsoft Press Computer dictionary, a server is defined as "n. 1. On a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers and disk drives, and **provides resources to computers functioning as workstations on the network**. 2. On the Internet or other network, a computer or program that **responds to commands from a client**. For example, a file server may contain an archive of data or program files; when a client submits a

request for a file, the server transfers a copy of the file to the client". Therefore, the appliance in question is device can be a computer functioning in between a client and another computer.

- C. ("**providing a continued service for said software application, wherein said hardware device is adapted to provide said continued service via a communication link between said hardware device and said manufacturer**") --

The invention provides mechanisms and methods for enabling secure remote access to privileged processes on a client computer. While the functionality provided by the instant invention is useful for installation and updating (continued service) of software application code used to provide application services, it is more generally useful in any environment that requires controlled access to privileged processes and features provided by a client computing platform (col. 5, ll. 7-15) - implemented including a variety of internetworking components such as Internet 101, public switched telephone network (PSTN) 102, and a wide area network (WAN) 110 (col. Ll. 27-30) --

- D. ("**continued service is performed by a third party service provider**") --Service provided by external Application Service Provider (col. 3, ll. 7-8) --

- E. ("**providing said software application in accordance with at least one of a software feature, a hardware configuration and a packaging material**") --

Providing controlled access to privileged processes and features (col. 5, ll. 11-15) -

One or more of appliances 117 may be configured as an application and/or file server (col. 6, ll. 10-12)--

- F. ("**providing said software application in accordance with a service level.**") --Prior art teaches that trusted entities are given privileges that allow "privileged processes" running on their behalf to execute various operations that might otherwise be forbidden by the operating system. Privilege levels are given a variety of names such as "user-level" to designate a most restrictive privilege set and "admin-level" to designate a least restrictive privilege set (col. 3, ll. 36-42) - Providing licensing information to user (col. 10, ll.40)
- G. ("**providing a fee rate in accordance with a level of end user usage**") --Charging a fee for software services is well known in the arts (see Cheng et al. US 6151643 col. 7, ll. 27-28 Note: this reference is given to established well known aspect in the art)--
- H. ("**hardware device providing a connection from said at least one end user's computer to said hardware device through at least one of a power line, a local area network, a wireless connection, and a direct connection**") --Using a variety of internetworking components such as Internet 101, public switched telephone network (PSTN) 102, and a wide area network (WAN) 110 (col. 11, ll. 27-30)
- I. ("**enclosing said hardware device within an enclosure**") --Enclosure is necessarily present in a client computer --
- J. ("**downloading said access software from said software manufacturer or from said hardware device**") --Downloading updated code into memory and/or storage devices within appliance 117 (col. 6, ll. 64-65) --
- K. ("**application software for access in conjunction with a web service.**") --A world wide web browser 201 is used to implement network connectivity and to provide a

mechanism through which software application functionality can be delivered (col. 6, ll. 66-67, col. 7, ll.1-2) (application has to necessarily be configured to be delivered via the internet) --

- L. ("**hardware device providing said software manufacturer with limited access to end user information on said hardware device.**") --A configuration component specifies a list of installable code components that are authorized for installation, wherein the agent will only execute privileged-mode functions in response to accesses by the user-mode code component when the installable code component is represented on the list(col. 4, ll. 47-52) --

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kouznetsov et al. (U.S 6931546), in view of Cheng et al. (US 6151643).
6. As per claims 16-23, Kouznetsov et al.'s invention has been previously disclosed.
7. Kouznetsov et al. did not explicitly describe a method/system in which the application was purchased. However, Cheng et al. describes an invention that relates to systems and methods for computer-based customer support, and more particularly, to systems, methods, and



products for automatically updating software products from diverse software vendors on a plurality of end-user, client computer systems. According to Cheng et al., the user pays for the services and for any for-fee software updates that the user may access in the course of using the service provided by the service provider computer 102(col. 7, ll. 27-30, col. 17, ll. 6-20).

8. Therefore, it would have been obvious for one skilled to charged client for application services provided. It would obvious for one to do so because it would legitimize the business by providing revenue that could potential sustain the existence of the Application Service Provider.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
10. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVENS J. AUGUSTIN whose telephone number is 571-272-6860. The examiner can normally be reached on 10am - 6pm M-F.
12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571)272-6779.

Evans J. Augustin  
February 9, 2008  
Art Unit 3621

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621